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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,965	12/13/2001	Robert J. Crowley	BSC-010C2	4630

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FAY KAPLUN & MARCIN, LLP  
150 BROADWAY, SUITE 702  
NEW YORK, NY 10038

EXAMINER
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LAMPRECHT, JOEL

ART UNIT	PAPER NUMBER
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3737

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/022,965

Applicant(s)

CROWELY, ROBERT J.

Examiner

Joel M. Lamprecht

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 39-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/25/02, 1/22/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims pending in the current application include claims 39-58. In the amendment Applicant acknowledges claims 39-58 as the only pending claims but failed to cancel all preceding claims. In the amendment filed on 9/17/02 Applicant declares that claims 1-20 are canceled and also declares that claims 39-58 are the only pending claims. It appears the latter was the intent of the Applicant and to expedite prosecution the Examiner has enclosed an action based on claims 39-58 wherein claims 1-38 are canceled without prejudice. Acknowledgement of this by the Applicant would be appreciated to help expedite the prosecution of the application.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 39-53, 55-58 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6119031 ('031) in view of Claims 1-27 of US Patent No. 6343227 ('227). Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 1-9 of Patent 6119031 disclose a spectroscopy device including a distal end, a light source on a first surface, a detector on the first surface, said detector comprising a first channel and second channel and filter disposed on the first channel, an optically transparent housing consisting of polystyrene, polycarbonate or methyl-methacrylate, the substrate comprising doped silicon, a heat sink disposed on the second surface, a lens on the light emitting portion, a mirror disposed on the light modulator for receiving light emitted by the light source, the light detector comprising an avalanche photodiode array. Patent '031 does not disclose using the filter to filter the light so that the output is in the UV range. Attention is then directed to the '227 patent which in claims 14 and 15 asserts that UV range light is provided through the filter by the light emitting portion. It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the UV light range and miniature spectrometer in order to allow for the optimum optical ranges for examination.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 39-51, 53-58 are rejected as being anticipated by Mahadevan-Jansen et al (5,842,995). Mahadevan-Jansen et al disclose a spectrometer device comprising a distal end with light emitting portion capable of providing UV light (Col 1 Line 35-55, Col 7 Line 5-454), a light detector (Col 13 Line 25-65), an interventional device, a bandpass filter associated with the light detector (Fig 6, Col 12 Line 20- Col 13 line 27), a light source (Col 5 Line 45 – Col 6 Line 15), a lens (Col 6 Line 5-45), the filter permitting light output in the UV range as is a property of UV Raman spectroscopy methods (Col 7 Line 5-65), a substrate for disposing the light emitter and detector (Col 6 Line 15-32), a modulator and mirror disposed on the surfaces of the same substrate for receiving light from the light source (Col 6 Line 65- Col 7 Line 25, Col 7 Line 35-45, Table 1, Figure 5), a substantially transparent window (Col 4 Line 5-30), an optical device including a lens (Col 12 Line 40 - Col 13 Line 20), filter (Col 12 Line 40 – Col 13 Line 2), mirror (Col 12 line 40 – Col 13 Line 2, and a hologram (Col 13 Line 3-20). Mahadevan-Jansen et al also disclose connecting the spectrometer to a power source (Table 1, Col 13 – Col 14), measuring optical properties of light from tissue (Col 7 Line 65 – Col 9 Line 57), specifically for characterizing tissue.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 39-58 rejected under 35 U.S.C. 103(a) as being unpatentable over Mahadevan-Jansen et al in view of Vari (5,503,559). Mahadevan-Jansen et al disclose a spectrometer device comprising a distal end with light emitting portion capable of providing UV light (Col 1 Line 35-55, Col 7 Line 5-454), a light detector (Col 13 Line 25-65), an interventional device, a bandpass filter associated with the light detector (Fig 6, Col 12 Line 20- Col 13 line 27), a light source (Col 5 Line 45 – Col 6 Line 15), a lens (Col 6 Line 5-45), the filter permitting light output in the UV range as is a property of UV Raman spectroscopy methods (Col 7 Line 5-65), a substrate for disposing the light emitter and detector (Col 6 Line 15-32), a modulator and mirror disposed on the surfaces of the same substrate for receiving light from the light source (Col 6 Line 65- Col 7 Line 25, Col 7 Line 35-45, Table 1, Figure 5), a substantially transparent window (Col 4 Line 5-30), an optical device including a lens (Col 12 Line 40 - Col 13 Line 20), filter (Col 12 Line 40 – Col 13 Line 2), mirror (Col 12 line 40 – Col 13 Line 2, and a hologram (Col 13 Line 3-20). Mahadevan-Jansen et al also disclose connecting the spectrometer to a power source (Table 1, Col 13 – Col 14), measuring optical properties of light from tissue (Col 7 Line 65 – Col 9 Line 57), specifically for characterizing tissue.

6. Mahadevan-Jansen et al do not mention the production of the window from polystyrene, polycarbonate, or methyl-methacrylate, rather they teach using a transparent Teflon window for the window material. Attention is then directed to the secondary reference by Vari, which teaches the use of PMMA, polystyrene and other silica-core fibers to allow for the transmission of UV light (Col 10 Line 5-50). It would have been obvious to one having ordinary skill in the art at the time of the invention to

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have constructed the window out of PMMA or polystyrene instead of Teflon to allow for UV light transmission through the windowed section of the miniature spectrometer disclosed by Mahadevan-Jansen et al as Teflon and quartz envelopes also allow UV light transmission.

### ***Conclusion***

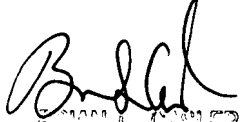
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joel M. Lamprecht whose telephone number is (571) 272-3250. The examiner can normally be reached on Monday-Friday 7:30AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on (571)272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

4/13/07  
JML

  
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